



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Pankaj K. Jha
Serial No.: 09/881,493
Title: PROGRAMMABLE PROTOCOL PROCESSING ENGINE FOR
NETWORK PACKET DEVICES
Filed: June 14, 2001
Attorney Docket No.: 0325.00482
Examiner: Patel, H.
Art Unit: 2154

CERTIFICATE OF MAILING

I hereby certify that this letter, the response or amendment attached hereto are being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 14, 2006.

By:

Mary Donna Berkley
Mary Donna Berkley

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal by an attorney either of record or acting under 37 CFR 1.34.

REMARKS

Review is requested for the following reasons:

1. The Examiner has clearly made the following errors in the rejection(s).

In rejecting the independent claims 1 and 10, the Examiner made an error by improperly substituting the phrase "only one of said first parameters" in place of the claimed phrases "each one of said first parameters". Since the rejections are not based upon the plain language actually found in the claims, the rejections cannot be sustained. See the arguments in the Amendment After Final (AAF) on page 13.

2. The Examiner has omitted one or more elements needed to make a *prima facie* rejection.

Regarding independent claim 1, the Examiner has failed to show that Ogawa et al. explicitly or inherently disclose a database circuit configured to store a plurality of pointer values for a plurality of first parameters defined by a network protocol. The text cited in the rejection does not mention a database storing pointers. The Examiner does not explain what element(s) of Ogawa et al. he believes to be similar to the claimed database circuit. See the discussion in the AAF on pages 11-12.

Furthermore, the Examiner has failed to show that Ogawa et al. explicitly or inherently disclose a processing circuit configured to (i) process a particular one of the first parameters in an incoming packet received by the assembly in accordance with the corresponding pointer value to produce a second parameter and

(ii) present an outgoing packet from the assembly containing the second parameter. The text cited in the rejection does not mention any processing circuits. Instead, the cited text discusses IP protocol and TCP protocol. See the discussion in the AAF on pages 13-14. As such, the rejection of claim 1 cannot be sustained in an appeal.

Regarding independent claim 10, the Examiner has failed to show that Ogawa et al. explicitly or inherently disclose a first circuit configured to delineate a receive frame received from a first network having a first network protocol to produce an incoming packet. None of the text cited in the rejection discusses a circuit configured to delineate a receive frame from a network. The Examiner does not explain what element(s) of Ogawa et al. he believes to be similar to the claimed first circuit. See the arguments in the AAF on pages 15-16.

Furthermore, the Examiner has failed to show that Ogawa et al. explicitly or inherently disclose a second circuit configured to (i) store a plurality of pointer values for a plurality of first parameters defined by the first network protocol, wherein each one of the first parameters is associated with a corresponding one of the pointer values, (ii) process a particular one of the first parameters in the incoming packet in accordance with the corresponding pointer value to produce a second parameter, and (iii) present an outgoing packet containing the second parameter. The text cited in the rejection does not mention a second circuit. The Examiner also does not explain what

element(s) of Ogawa et al. he believes to be similar to the claimed second circuit. See the arguments in the AAF on pages 16-17.

Furthermore, the Examiner has failed to show that Ogawa et al. explicitly or inherently disclose a third circuit configured to frame the outgoing packet to present a transmit frame to a second network. None of the text cited in the rejection discusses a circuit configured to frame outgoing packets. The Examiner does not even attempt to explain what element(s) of Ogawa et al. he believes to be similar to the claimed third circuit. See the arguments in the AAF on pages 17-19. As such, the rejection of claim 10 cannot be sustained in an appeal.

3. The Examiner fails to show proper motivation for making the asserted obviousness rejection (35 U.S.C. §103).

The Examiner has failed to provide evidence of motivation to modify/combine Ogawa et al. with the various other references. Instead, the Examiner makes overly broad conclusory statements in place of actual evidence. See the arguments in the Amendment After Final on (i) page 21 for Ogawa et al. with Official Notice, (ii) page 22 for Ogawa et al. with Gabrick, (iii) pages 23-24 for Ogawa et al. and Gabrick with Wilford and (iv) pages 25-26 for Ogawa et al. with Yanagihara. As such, the 103 rejections cannot be sustained in an appeal for lack of actual evidence of motivation.

The Examiner has failed to provide any evidence to rebut the non-analogous US classifications argued in the Amendment After Final on (i) pages 22-23 for Ogawa et al. and Gabrick and (ii) page 24 for Ogawa et al., Gabrick and Wilford. In the absence of any

rebuttal evidence, the corresponding 103 rejections cannot be sustained in an appeal.


Applicant's representative believes that the Examiner has failed to establish *prima facie* cases for the rejections. The rejections are simply lists of lines in the references with little to no explanation how the lines are being applied to the claims. Applicant should not have to wait for the appeal processes to see how the references are actually being interpreted and used. Furthermore, all of the alleged motivations to modify/combine the references appear to be merely conclusory statements with no supporting evidence. Therefore, none of the rejections can be sustained in appeal and prosecution should be reopened.

The Examiner is respectfully invited to call the Applicant's representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 50-0541.

Respectfully submitted,

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Dated: December 14, 2006

Docket No.: 0325.00482

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